## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

MARTIN GROHMAN

Serial No.: 10/634.497

Filed: August 5, 2003

GROOVED DECKING BOARD

Docket No.: 34192

Confirmation No.: 8665

Group Art Unit No.: 3635

Customer No.: 23589

Examiner: Robert Canfield

Assistant Commissioner of Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

## STATEMENT

In accordance with Applicants' duty of candor toward the Office, Applicants previously advised the Examiner of the existence of U.S. Patent Application 10/634,499, filed August 5, 2003, entitled HIDDEN DECK FASTENER SYSTEM. An office action was mailed in the '499 application on September 27, 2006, in which several claims were rejected as being anticipated by one or more references. A copy of that action is enclosed.

Respectfully submitted,

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ATTORNEYS FOR APPLICANT(S)



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademurk Office Address: COMMISSIONER FOR PATENTS P.O. Box 1430 Adexametra, Virginia 22313-1450 www.uniplo.gov

PPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,499	08/05/2003	Murtin Grohman	33105 8662	
7590 09/27/2006			EXAMINER	
HOVEY WILLIAMS LLP Suite 400 2405 Grand Boulevard		RECEIVED	CANFIELD, ROBERT	
			ART UNIT	PAPER NUMBER
Kansas City, N	O 64108	OCT 0 2 2006	3635	
			DATE MAILED: 09/27/2006	
	L	HOVEY WILLIAMS LIP		

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Defice Action Summary    Examiner		Application No.	Applicant(s)
Examiner  The MAILING DATE of this communication appears on the cover sheet with the correspondence address  AS HORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAY  WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  The SIX 69 MONTHS from the mailing date of this commod and purple is the application to become ABANCOKIET, or the country of the communication appears on the cover sheet with the correspondence address  AS HORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAY  WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  The SIX 69 MONTHS from the mailing date of this commod and purple is the communication of the common and purple is the common	Office Action Summer	10/634,499	
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A) Claim(s) 28-40.42-52 and 55-61 is/are pending in the application.  4a) Of the above claim(s)	3)☐ Since this application is in condition for allowanc closed in accordance with the practice under Ex	ection is non-final.	, prosecution as to the merits is
Salare allowed.   Salare allowed.	Disposition of Claims		1, 100 0.0. 210.
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Information Disclosure Statement(s) (PTO/SB/08)   Paper No(s)/Mall Date   Pa	Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO/85/08) Paper No(s)/Mall Date	<li>5) Notice of Informal Pa</li>	

Application/Control Number: 10/634,499 Art Unit: 3635

- 1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/31/06 has been entered. Claims 28-40, 42-52 and 55-61 are pending. Claims 1-27, 41, 53 and 54 have been canceled.
- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 4. Claims 28-40, 42-52 and 55-61 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,470,641 to Faure.

Faure provides first 12 and second 14 boards each having upper and lower lips separated by grooves 36/38 on opposite sides. The boards 12/14 are fastened to spaced joists 46 by metal fasteners 16. The fasteners 16 have a base 22 and a pair of protrusions 24/26 above the base at a height. The thickness of the lower lips or vertical distance to the grooves from the bottom of the boards is

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greater than the distance between the base 22 and protrusions 24/26 of the fasteners 16 to provide pressure of the protrusions [bottom of column 2] to provide a holding force. The metal of the fasteners is inherently a resilient material.

 Claims 28-30, 36 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,314,699 to West.

West provides first and second boards 16 each having upper and lower lips separated by grooves 18 on opposite sides. The boards 16 are fastened to spaced joists 14 by fasteners 12. The fasteners 12 have a base and a pair of protrusions 28/48 above the base at a height. The thickness of the lower lips 22 or vertical distance to the grooves from the bottom of the boards is greater than the distance between the base and tips 48 of protrusions 28 of the fasteners 16. While the tips 48 are not disclosed as bearing on the lower lips to provide an interference type fit they are operable to rigidly couple to the joists and are capable of doing so in an interference type manner if the gap between the boards was slightly increased. As such they are "operable to" exert a downward holding force as recited in claim 37 but do not "exert" a downward holding force as required in claim 31. Figure 1A appears to show at least about a 5% difference.

 Applicant's arguments filed 08/31/06 with respect to the West '699 patent have been fully considered but they are not persuasive. Art Unit: 3635

Applicant argues that West fails to provide the dimensions required to the protrusions to exert a downward force of the lower lips. Applicant is misinterpreting how the both the previous and instant examiner are defining "F" in order to meet the claims. "F" as applied to the claims is the distance from the bottom of fastener 12 to protrusions 48. This distance as shown in Figure 1A is clearly smaller than the distance "E" defined from the bottom of the boards 16 to the top of the lower lips 22 or the beginning of the grooves 18. While not disclosed as exerting a downward pressure of the lower lips 22 the protrusions 48 are quite capable of doing so if the spacing between the boards were slightly increased and as such are considered to meet the claims which have been rejected above.

 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Note the references listed on PTO-892 form that was attached to the Advisory Action mailed 08/28/06.

 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield Primary Examiner Art Unit 3635

09/16/06